

REMARKS/ARGUMENTS

Applicants appreciate the thorough review of the present application as evidenced by the Official Action. The Official Action objects to Claims 2 and 4 and rejects Claims 1-12 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. In addition, the Official Action rejects Claims 1, 2, 5, 6, 7, 9, and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over the "Beyond the Banner Ad" article by Leslie Walker ("Walker") in view of official notice. The Official Action rejects Claims 3 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Walker and official notice and further in view of U.S. Patent Application Publication No. 20020052816 to Clenaghan et al. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker and official notice and further in view of U.S. Patent No. 6,074,434 to Cole et al.

Based upon the attached 37 C.F.R. § 1.131 Declaration and following remarks, Applicants respectfully traverse the rejections of Claims 1-12. In addition, Claims 2 and 4 have been amended to overcome the objections raised in the Official Action. Dependent Claims 15-18 have been added to further define other unique aspects of the present application. Moreover, dependent Claims 13 and 14 have been cancelled. In light of the currently and previously presented amendments and subsequent remarks, Applicants respectfully request reconsideration and allowance of the present application.

A. The Objection of Claims 2 and 4 are Overcome

The Official Action objects to Claim 2 as reciting "client devices" rather than "client device." Accordingly, Claim 2 has been amended to properly recite a singular client device.

Claim 4 recites executable code as method steps and, thus, the Examiner believes Claim 4 should recite "code which detects conditions . . . and code which generates updates" rather than "the executable code comprises: detecting conditions. . . and generating updates." In order to overcome the objection, Applicants have amended Claim 4 to recite that "the executable code executing on the client device comprises instructions for: . . ."

In light of the amendments to dependent Claims 2 and 4, Applicants respectfully submit that the objections set forth in the Official Action have been overcome.

B. The Rejection of Claims 1-12 under 35 U.S.C. § 112, First Paragraph, is Overcome

The Official Action rejects Claims 1-12 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. In this regard, the Examiner finds that the previous amendment to independent Claims 1, 7, 11, and 12 adding the recitation of receiving an indication to purchase the offering of the seller directly via the associate's web site based on input from the client device was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicants respectfully submit that the rejections of Claims 1-12 under 35 U.S.C. § 112, first paragraph, are without merit. The Examiner finds that the previous amendment adding the recitation "receiving an indication to purchase the offering of the seller directly via the associate's web site based on input from the client device" is different than what is disclosed in the specification and drawings. The Examiner specifically relies on paragraph 41 and Figure 7 of the application, which the Examiner believes demonstrates that the "seller receives indication to purchase the offering of the seller directly based on input from the client device, with no teaching that the indication is received via the associate's web site." However, paragraph 41 and Figure 7 relate to the steps involved in invoking a purchasing service. As stated in paragraph 32 of the present application, "[i]f the user selects the product offering, a purchasing service 278 will be invoked (step 330) (see Figure 7)." While the purchasing service may provide a direct command to the associate's web site, the initial indication to purchase is still provided by the client device at the associate's web site. In the above-quoted sentence, the indication occurs when the user selects the product offering, which is provided via the associate's web site. Thus, the user still inputs an indication to purchase the offering via the associate's web site irrespective of the purchasing service used. Furthermore, several instances in the specification indicate that a user may access an associate website and input a request to purchase an offering directly via the associate's web site (See e.g., Figure 3 and paragraphs 20 and 32 of the present application).

Accordingly, Applicants respectfully submit that the rejection of Claims 1-12 under 35 U.S.C. § 112, first paragraph, has been overcome.

C. *The Rejections of Claims 1-12 under 35 U.S.C. § 103(a) are Overcome*

In light of the Official Action, a 37 C.F.R. § 1.131 Declaration signed by the Applicants is attached to “swear behind” Walker, and the Applicants respectfully submit that the Rule 131 Declaration presented is sufficient to overcome the rejections under 35 U.S.C. § 103(a) in the Official Action. The Rule 131 Declaration demonstrates that the Applicants actually reduced the present invention to practice prior to the publication date of Walker. Therefore, Walker cannot be cited against the present application as prior art under 35 U.S.C. § 103(a).

Actual reduction to practice requires that: 1) the party constructed an embodiment or performed a process as recited by the claimed invention, and 2) the embodiment or process operated for its intended purpose. The source code and web sites provided in Exhibits 1-9 substantiate that the Applicants constructed code that worked for its intended purpose prior to August 31, 2000, the publication date of Walker. In particular, Exhibits 1-9 disclose the methods and computer-readable mediums of independent Claims 1, 7, 11, and 12 of the present application that include: receiving, at a first server device from the client device, a request for content, wherein the content is contained in an associate’s web site (i.e., AARP Trips n’ Travel) that includes an offering (i.e., EBO within the Sabre Affiliate Ad) made by a seller (i.e., Sabre), wherein the first server maintains the associate’s web site, and wherein an associate is an entity other than the seller (Exhibits 2-7); providing, by the first server to the client device, the associate’s web site including the requested content (Exhibits 2-7); substantially continuously providing the client device updates to variable data (i.e., availability) of the offering referenced in the associate’s web site, wherein the variable data of the offering is subject to update by a second server (Exhibit 9); and receiving an indication to purchase the offering of the seller directly via the associate’s web site based on input from the client device (Exhibit 8).

For the forgoing reasons, Walker may not be relied upon as prior art, and none of the cited references, taken either individually or in combination, teach or suggest the methods and computer-readable mediums of independent Claims 1, 7, 11, and 12 or any of the claims that depend therefrom. Thus, the rejection of Claims 1-12 under 35 U.S.C. § 103(a) is overcome.

CONCLUSION

As discussed previously, Walker is not available as a reference under § 103(a) to support an obviousness rejection. Since all the rejections under 35 U.S.C. § 103 are based on Walker, Applicants respectfully request that the rejections be withdrawn. Accordingly, in view of the remarks and amendments presented above, it is respectfully submitted that Claims 1-12 of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted, .



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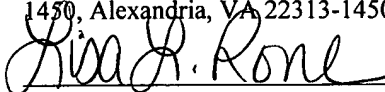
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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 27, 2005.



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